

REMARKS

Claim Rejections

Claims 12 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 4 and 8-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Waggamon et al. (6,049,289). Claims 2, 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Waggamon as applied to claims 1 and 13 above, and further in view of Kawaguchi (2002/0099967).

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

Claim Amendments

By this Amendment, Applicant has cancelled claim 14 and has amended claims 1, 12, and 13 of this application. Claim 15 has also been added and is based on cancelled claim 14. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art.

The amended claims are directed toward: a high-security encoding device for a remote controller and method of use in which a timer is used to provide a transmitting time and a ***time-between-operations***. As a result, Applicant's device and method substantially prevents mask-replay attacks, thereby enhancing the security of the remote control system. In addition, a T_T register is disposed in the decoding device 40 to store the transmitted transmitting time (T_T). See, p. 12, ll. 15-28; p. 14, l. 12-p.15, l. 24; Figs. 4B and 7.

In comparison, Waggamon teaches a remote control garage door system including a transmitter 44 which the Examiner has cited as teaching Applicant's encoding device having a timer for determining transmitting time. However, Applicant has reviewed the cited disclosure of col. 4, ll. 43-54 (as well as, col. 5, ll.

31-34, and col. 7, ll. 38-42) and determined that Waggamon employs a **counter**, not a timer. As a result, Applicant submits that this prior art device cannot effectively prevent a mask-replay attack. Furthermore, the reference fails to teach anything about calculating and applying a time-between-operations.

Waggamon does not teach: a high-security encoding device for a remote controller and method of use in which a timer is used to provide a transmitting time and a time-between-operations.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure or method, it must clearly disclose each and every feature of the claimed structure or method. Applicant submits that it is abundantly clear, as discussed above, that Waggamon does not disclose each and every feature of Applicant's new and amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Waggamon cannot be said to anticipate any of Applicant's new and amended claims under 35 U.S.C. § 102.

Kawaguchi is cited as teaching a 32 bit timer; a 2 byte Specifier and node ID; activating an encoding device and a timer and encrypting the transmitting time and identity and the mode value; checking a state on a decoder and suspending the timer if the state is idle and sending a transmission if the state is active. Applicant does not acquiesce to these characterizations and submits that, in any event, Applicant does not believe the reference teaches a high-security encoding device for a remote controller and method of use in which a timer is used to provide a transmitting time and a time-between-operations.

Accordingly, even if the teachings of Waggamon and Kawaguchi were combined, as suggested by the Examiner, the resultant combination does not suggest: a high-security encoding device for a remote controller and method of use in which a timer is used to provide a transmitting time and a time-between-operations.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected

prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Waggamon or Kawaguchi that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Waggamon nor Kawaguchi disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new and amended claims.


Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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